

REMARKS

Claims 1-9 remain in this application. Claims 10-13 have been canceled without prejudice to the filing of a divisional application. No new matter has been added by this amendment. Applicants respectfully request review and reconsideration of this application.

In the current office action (Final Office Action) dated November 1, 2004, the Examiner rejected Claims 1 and 9 under 35 U.S.C. § 103(a) as being unpatentable over Sorth in view of Wemyss. The Examiner rejected Claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Sorth in view of Wemyss, and further in view of Jasmagy, Jr. Claims 2, 3 and 5-8 were withdrawn from consideration as being drawn to a nonelected species or invention, there being no allowable generic or linking claim. Applicants respectfully traverse these rejections and submit that the rejections of Claims 1, 4 and 9 should be withdrawn. Therefore, Claims 2, 3 and 5-8, which depend from generic Claim 1 should also be considered by the Examiner.

The Examiner's rejection of Claim 1 is based upon Sorth in view of Wemyss. In response, Applicants assert that: (1) there is no teaching or suggestion to combine Sorth and Wemyss; (2) even if these references were combined, they would not disclose all of the limitations of Claim 1; and (3) there are secondary indicia of the non-obviousness of this invention.

Combining Wemyss and Sorth References Would Not Be Obvious

There is no teaching or suggestion to combine the non-ferrous shell of Wemyss that provides friction for superior magnetic coupling of a magnetic object to a magnetic base with the magnetic device of Sorth that attaches directly to a metal surface. In both Wemyss and Sorth, there is no suggestion or disclosure to combine the references. Furthermore, Wemyss and Sorth address to two vastly different problems. In Sorth, the magnetic base is attached directly to a metallic surface of the vehicle for the purpose of

holding the device to the vehicle. In Wemyss, the magnetic base is fixedly attached to a nonferrous surface and used as a magnetic coupler in combination with another magnetic holding device. Furthermore, in Wemyss there is an adhesive layer between the magnetic base and the surface to which it is fixedly attached. Therefore, it would not be obvious to combine elements of the fixed attachment device in Wemyss with the magnetic attachment device of Sorth.

Combining Wemyss and Sorth References Still Does Not Disclose All Limitations

Even if the Sorth and Wemyss references were combined, they would not disclose all the limitations of Claims 1, 4 and 9. Claims 1, 4 and 9 include the limitation: "a cushion that is connected to the magnet, wherein at least a portion of the cushion is positioned between the magnet and the exterior surface of the vehicle when the magnet is secured to the exterior surface of the vehicle and wherein the cushion is comprised of a material that substantially resists scratching the exterior surface of the vehicle." Applicants respectfully assert that Wemyss does not disclose either a portion of the cushion positioned between the magnet surface to which it attaches or a cushion comprised of a material that substantially resists scratching.

The Examiner argued that Wemyss "clearly teaches placing a cushion between a magnet and a surface being magnetically coupled with the magnet so as to provide for a non-skid surface and so as to inherently prevent marring of the object/item/surface." Therefore, according to the Examiner, in the case of Sorth, based upon the teaching of Wemyss, the cushion would be able to assume a position that is between the magnet and the exterior surface of a vehicle for the cup holder. Applicants respectfully disagree.

The Examiner's analysis is flawed insofar as Wemyss discloses a magnetic coupler in which an object such as the holding device is magnetically coupled to a magnetic base, not directly to the surface of the vehicle. In the Wemyss device, the magnetic base is attached to the surface of the automobile with a layer of adhesive,

between the magnetic base and an interior surface of a vehicle to permanently affix the magnet to the surface. (Column 6, Lines 48-56). No portion of the boot disclosed in Wemyss is positioned between the magnetic base and an interior surface of the vehicle. The magnetic base is permanently affixed to the interior surface of the car, in a manner guaranteed to mar the surface.

Moreover, Wemyss discloses an alternate embodiment including a lower ferrous disk positioned underneath the magnet of the magnetic base which allows the base to be coupled to a magnetized surface. In this embodiment, the rubber boot does not cover the surface of the lower ferrous disk in contact with the magnetized surface to which it is connecting. (Column 6, Lines 41-55). In this embodiment the lower ferrous disk allows the magnetic base to be coupled to a magnetized surface; however there is no protective layering between this magnet and the surface to which it is coupled. Thus, this structure would be unsuitable for attachment to the exterior surface of the vehicle.

Furthermore, Wemyss discloses that: "the upper portion 'boot' includes a high friction, textured outer surface [and] [t]he soft durometer textured surface provides a 'non-skid' surface in which devices are magnetically coupled" (Column 6, Lines 7-10) and that "such texture can take the form of scoring, dimpling or a combination of the two." (Column 6, Lines 10-11). Wemyss further notes that the outer shell is textured to provide friction for superior magnetic coupling. Thus, this textured boot would not resist scratching the exterior surface of a vehicle, and would therefore be unsuitable to provide the cushioned boot of the present invention.

Finally, Wemyss simply describes the shell as a low durometer nonferrous shell. (Column 13, Lines 15-20). The durometer is the international standard for the hardness measurement of rubber, plastic and other non-metallic materials, described in the American Society for Testing and Material specification ASTM D2240. While the durometer tests resistance of materials toward indentation and provides an empirical hardness value, a soft surface does not inherently encompass a non-abrasive surface.

(see <http://www.matweb.com/reference/shorehardness.asp>). Wemyss therefore fails to disclose a material that would resist scratching the exterior surface of a vehicle.

Thus, Wemyss, does not disclose the limitations in Claims 1, 4 and 9 of the present application that the "cushion is positioned between the magnet and the exterior surface of the vehicle and...comprised of a material that substantially resists scratching the exterior surface of the vehicle."

#### Objective Evidence of Non-Obviousness

In addition to these deficiencies in the Examiner's *prima facie* case, there is strong objective evidence of the nonobviousness of Applicant's invention. The secondary indicia of long-felt need and commercial success of the BottleBoot™ bottle holder, a bottle holder constructed according to this invention, provide objective evidence of non-obviousness.

As indicated by the attached declaration of Richard Umbrell under 37 C.F.R. § 1.132, there has been a long felt need in the automobile reconditioning industry for a storage container for various wax and polish bottles that temporarily attaches to and is easily removed from the exterior of a vehicle and that would not mar the surface of the vehicle. Mr. Umbrell and several of his customers indicated that until the storage container of the present invention was introduced, no storage or attachment device addressed this need of automobile detailers and that they instead would place the bottles on top of the car or beside their feet when working and invariably the bottles would fall, get kicked or roll away. (Umbrell Decl. ¶3, Exh. F,G). Mr. Umbrell further indicated that solutions such as the use of an apron with pockets have been tried to address the problem. Mr. Umbrell stated that this prior art solution was unsatisfactory in that the position of the detailer leaning into the car to buff the surface often caused the squeeze bottle to be pressed between his torso and the car resulting onto excess product being leaked on to already cleaned surfaces of the car. (Umbrell Decl. ¶3) That is, the lack of convenient stowage for product bottles continued after the disclosure

of both the magnetic cup holder of Sorth and the magnetic coupler of Wemyss. As further indicated by Richard Umbrell in his declaration and by his customers within the automobile reconditioning industry, the bottle holder produced in accordance with the invention is the first and only product in the industry that solves the problem of where to stow the wax and polish bottles when working on an automobile. (Umbrell Decl. ¶5, Exhs. A,B,C,D,E).

The commercial success, broad industry appreciation and immediate acceptance of the Bottle Boot<sup>TM</sup> bottle holder, a product produced in accordance with the invention of this application, is further evidence of the non-obviousness of this invention. During the first year this product was on the market, 9,605 units were sold to major distributors of automobile reconditioning products located across the United States. (Umbrell Dec. ¶14). As indicated by Mr. Umbrell, this number of sales for a new product represents a large volume of sales for a small company in the auto reconditioning industry. *Id.* Both the Federal Circuit and district courts have repeatedly noted that commercial success of the commercial embodiment of an invention is uncontroverted evidence of non-obviousness and is entitled to fair weight. See, e.g., *Leviton Mfg. Co. v. Universal Sec. Instruments, Inc.*, 304 F. Supp. 2d 726, 752 (D. Md., 2004) (citing *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 1391 (Fed. Cir. 1988)). The commercial success of the Bottle Boot<sup>TM</sup> bottle holder can be directly attributed to the claimed features of the invention since the only advertising for this product involved sending one sample device to current customers along with a copy of a flyer specifically describing the unique features of the product. (Umbrell Decl. ¶17, Exh. H).

Moreover, the Federal circuit has repeatedly noted that commercial success can be established by customer testimony. See, e.g., *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 668 (Fed. Cir., 2000); *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1351 (Fed. Cir., 2000); *Pro-Mold v. Great Lakes Plastics*, 75 F.3d 1568 (Fed. Cir., 1996); *Tate Access Floors Inc. v. Interface Architectural Resources*, 185 F. Supp. 2d 588, 604 (D. Md. 2002). For example, in *Winner Int'l Royalty Corp. v. Wang*, the Federal Circuit

affirmed a finding of commercial success based on significant sales in the relevant market and a survey of customers indicating that the patented improvement was the reason they purchased the product. *Winner Int'l Royalty Corp*, 202 F.3d at 1351. Furthermore, in *Pro-Mold v. Great Lakes*, the Federal Circuit noted that Pro-Mold's lack of previous experience in the relevant market combined with its high sales of the patented product provided an inference of a nexus between its commercial success and the patented invention and are thus probative evidence of non-obviousness. *Pro-Mold*, 75 F.3d at 1574. Finally, in *Tate Access Floors, Inc. v. Interface Architectural Res., Inc.*, a district court noted that affidavits from customers insisting on the particular product and noting that dealers were overjoyed by the product provided evidence of a nexus between the claimed invention and the commercial success of the commercial product. *Tate Access Floors, Inc.*, 185 F. Supp. 2d 588, 604 (D. Md. 2002)

Likewise, customer feedback regarding the Bottle Boot<sup>TM</sup> bottle holder supports attributing this commercial success to the claimed features of the product. For example, Mr. Carley, an auto reconditioning supplies distributor in New Mexico, stated that the main reason my customers like the Bottle Boot<sup>TM</sup> bottle holder is "it doesn't scratch the paint because of the unique rubber bottom." (Umbrell Decl. ¶11, Exh. E). Mr. Kinzy, owner and president of a car care product supplier in Arizona, applauded the introduction of the Bottle Boot<sup>TM</sup> bottle holder as the perfect device for consolidating tools necessary for automobile reconditioning, particularly noting the magnetic bottom. (Umbrell Decl. ¶10, Exh. D). Mr. Peterson of Auto Wax Supply, wrote that he "immediately recognized the usefulness of this product [the Bottle Boot<sup>TM</sup> bottle holder] for my customers" and that what he "especially liked about the bottle boot is that there is a cushion between the magnet and where it attaches to the car." (Umbrell Decl. ¶12, Exh. F). Mr. Henderson of Southern Detail Suppliers states that he has been selling the Bottle Boot<sup>TM</sup> bottle holder for about one year and that he has received much positive feedback from his customers regarding the "handiness of the boot for storing their wax and polish bottles at hand while they work on a car...and the fact that it does

not mar the surface of the car when it is removed.” (Umbrell Decl. ¶12, Exh. G)

This customer testimony supports the proposition that the commercial success of the product made in accordance with this patent application, i.e. the Bottle Boot™ bottle holder, was a direct result of the features claimed in this application, namely the magnetic bottom, the cushion connected to the magnet and positioned between the magnet and the exterior surface of the vehicle and the tapered sleeve of the bottle holder. Furthermore, this testimony shows that once introduced to the automobile detailing market, the product made in accordance with the invention of this patent application attained immediate and broad acceptance within the automobile detailing market since the customers represented by these letters include major distributors of automobile cleaning products across the United States with over 79 years combined experience in the industry. (Umbrell Decl. ¶15).

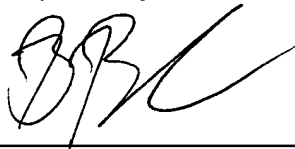
Thus, the long felt, but previously unmet need in the automobile detailing industry along with the commercial success and broad acceptance by the industry of a product made in accordance with the invention described in this patent application compel the conclusion that the Applicants’ invention is not obvious.

In view of the foregoing, Applicants respectfully submit that a case of obviousness has not been established for Claims 1, 4 and 9. Claims 2, 3, and 5-8 depend on Claim 1 therefore they should be allowable for at least the reason that they depend on an allowable base claim. Reconsideration and withdrawal of the rejections is respectfully requested, and a timely Notice of Allowability is solicited. To the extent that it would be helpful to placing this application in condition for allowance, Applicants encourage the Examiner to contact the undersigned counsel and conduct a telephonic interview.

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To the extent necessary, Applicants petition the Commissioner for a one-month extension of time, extending to March 1, 2005, the period for response to the Office Action dated November 1, 2004. A check in the amount of \$455.00 is enclosed for the one-month extension of time (\$60.00) pursuant to 37 CFR §1.17(a)(1) and (\$395.00) for request for continued examination (RCE) pursuant to 37 CFR § 1.17(e). The Commissioner is authorized to charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0639.

Respectfully submitted,



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Date: March 1, 2005

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Enclosure: Declaration of Richard Umbrell